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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,574	11/16/2000	John M. Packes JR.	00-068	5486
22927 7590 07/16/2007 WALKER DIGITAL MANAGEMENT, LLC 2 HIGH RIDGE PARK STAMFORD, CT 06905			EXAMINER DURAN, ARTHUR D	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 07/16/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/714,574	PACKES ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Arthur Duran	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2007.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 13-27, 30-35 and 51-67 is/are pending in the application.
- 4a) Of the above claim(s) 13-27, 30-35 and 51-65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 66 and 67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 13-27, 30-35 and 51-65 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/24/07</u>   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 13-27, and 30-35, and 51-67 have been examined.

#### ***Response to Amendment***

2. The Amendment filed on 5/24/07 is sufficient to overcome the prior rejection.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/24/07 has been entered.

#### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 13-26, 30-35, and 51-53, drawn to providing coupons based on the status of a service queue, classified in 705/14.
  - II. Claim 27 and 62-65, drawn to providing coupons based on the hours of operation, classified in class 705/14.
  - III. Claims 54-61, drawn to providing coupons based on the status of an inventory, classified in class 705/14.
  - IV. Claims 66 and 67, drawn to settlement processing related to coupons, classified in class 705.

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Inventions I, II, III, and IV are based on different sets of Independent claims. Group I involves the steps of providing coupons based on the status of a service queue. Group II involves providing coupons based on the hours of operation. Group III is related to providing coupons based on the status of an inventory. Group IV is related to settlement processing related to coupons.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

During a telephone conversation with Carson Fincham at (203)461-7017 on 5/30/2007 a provisional election was made without traverse to prosecute the invention of Group IV, 66 and 67. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-27, and 30-35, and 51-65 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 66 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts (2003/0117635) in view of Barcelou ([2005/0211764])

Claim 66: Roberts discloses

receiving, by a central controller, reporting data from a plurality of vending machines (Figures 12, 1; [127]);

determining, by the central controller, a retailer identifier (Figures 3, 5, "Redemption Address"; and, Figures 1, 12);

determining, by the central controller, an offer identifier associated with the retailer identifier (Figures 3, 5, 12, 1);

determining, by the central controller, a vending machine identifier associated with the retailer identifier and the offer identifier (Figure 12, items 114 and 118);

identifying, by the central controller, a subset of the reporting data that was received from a vending machine from the plurality of vending machines, wherein the vending machine is identified by the vending machine identifier (Figures 12; );

determining, by the central controller and based on the subset of the reporting data received from the vending machine, a number of times that an offer identified by the offer identifier has been output by the vending machine during a specific time period ([112, 114, 100, 21, 114, 117]);

calculating, by the central controller and based at least in part on the number of times that the offer has been output by the vending machine during the specific time period, an amount owed by a retailer identified by the retailer identifier ([83, 100, 112]);

determining, by the central controller, contact information associated with the retailer([83, 100]);

and

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transmitting, by the central controller and based on the contact information, a bill for the amount owed to the retailer ([83]).

Also, note that Roberts discloses kiosk connected to manufacturer ([20, 30, 127]) and that the Remote User Station can be a kiosk ([127]).

Roberts discloses retailer and manufacturer coupons ([4, 8, 13]; Figure 5, item 70, "Manufacturer's Coupon"). And, note that the manufacturer's coupons involve payout to the retailer ([13, 83]). Also, Roberts discloses that the identity of coupon holder, issuer, redeemer, and other pertinent information can be identified and tracked ([43]).

Roberts does not explicitly disclose that the kiosks or coupon distributing stations can also be vending machines.

However, Barcelou discloses a kiosk/ATM/vending machine that provides coupons, accounting, ATM, credit/debit services and a variety of other services ([18]; claims 5, 6, 10, 11, 15). Also, Barcelou discloses multiple kiosks, that the kiosks can be connected (claims 5, 6, 10, 11, 15). Also, Examiner takes Official Notice that Barcelou's vending machine/kiosks/ATMs are uniquely identified. It is obvious, old, and well known that ATMs are uniquely identified and tracked because of the cash and information being transacted at an ATM.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Barcelou's further vending machine/kiosk/ATM and further ATM identifying to Roberts kiosk and identified Remote User Stations/kiosks. One would have been motivated to do this in order to provide services of interest to the user and better tracking/targeting.

Claim 67: The combination of the prior art discloses the above.

Roberts further discloses determining, by the vending machine, that the subset of reporting data is required to be transmitted to the central controller; determining, by the vending machine, the subset of reporting data summarizing metrics regarding offers output by the vending machine during the specific time period; and transmitting, by the vending machine, the subset of reporting data to the central controller ([21, 114, 117, 112, 113, 127]). Note in Roberts that the vending machine can function as the Remote User Station (Figure 12). And, note that the Remote User Station (Figure 2) provides the coupon information history “To/From Online Service”. Also, note that the placement of functions in Roberts can be varied (Figure 1, [127]) but that “User/Feedback Data” is provided from the user terminal to the “Marketing and Targeting” central controller.

#### ***Response to Arguments***

4. Applicant's arguments with respect to the claims have been considered but are moot in grounds of the rejection above.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

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Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Also, it must be presumed that the artisan knows something about the art apart from what the references disclose. *In re Jacoby*, 309 F.2d 513, 135 USPQ 317 (CCPA 1962). The problem cannot be approached on the basis that artisans would only know what they read in references; such artisans must be presumed to know something about the art apart from what the references disclose. *In re Jacoby*. Also, the conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint of suggestion a particular reference. *In re Bozek*, 416 F.2d 1385, USPQ 545 (CCPA 1969). And, every reference relies to some extent on knowledge or persons skilled in the art to complement that which is disclosed therein. *In re Bode*, 550 F.2d 656, USPQ 12 (CCPA 1977).

And, when there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103.

If a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, §103 likely bars its patentability. Moreover, if a technique has been



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used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007).

### *Conclusion*

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

aa) Please note the attached prior art articles describing ATM/vending machines providing coupons;

a) Eaton (6,012,050) discloses connecting a vending machine, POS, and coupon functions:

“(35) The separation of business functionality from delivery channels can be applied in systems other than financial service systems. The invention can also be applied in the retail system, in which the customer service channels will include a Point Of Sale till, an automatic vending machine, and a loyalty card processing terminal, and the operation means will include a relationship manager to provide a base for customer services such as special offers, posting of coupons to selected addresses etc. Also, in a communications system, the customer service channels will include conventional telephone, cable television and interactive television facilities”;

b) Srinivasan (20020046096) discloses providing coupons in order to satisfy a user for waiting in a queue;

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c) Smith (WO 9728510) discloses interactions between a vending machine, retailer, and couponing;

d) Takano (JP408016658), Hoshi (JP405101236), and Kitagawa (JP02003141646) discloses presenting a user with coupons in order to satisfy a user for waiting in a queue.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Arthur Duran  
Primary Examiner  
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5/30/07

This Information Disclosure Statement is filed in accordance with 37 C.F.R. §§1.56, 1.97 and 1.98. The items listed on the accompanying Form PTO-1449 may be deemed to be pertinent to the above-identified application and are made of record to assist the Patent and Trademark Office in its examination of this application. The Examiner is respectfully requested to fully consider the items listed on the enclosed copy of Form PTO-1449 and to independently ascertain their teaching.

Fees

No fee is believed to be due under 37 C.F.R. § 1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. §1.97(b)(4), before the mailing of a first Office action after the filing of a request for continued examination under § 1.114.

The Commissioner is hereby authorized to charge any additional fees which may be required for this Information Disclosure Statement, or credit any overpayment to Deposit Account No. 50-0271.

Respectfully submitted,



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May 24, 2007